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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/277,226	03/26/1999	ISABELLE BARA	05725.0362-0	3233

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EXAMINER

BERMAN, ALYSIA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 02/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/277,226

Applicant(s)

BARA ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 and 62-67 is/are pending in the application.
- 4a) Of the above claim(s) 20-22, 24, 30-39, 41, 58 and 67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 23, 25-29, 40, 42-57, 59, 60 and 62-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 20.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of the response filed January 17, 2002. Claims 1-60 and 62-67 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 26, 2001 has been entered. Claims 1 and 2 have been amended.

Election/Restrictions

Applicant's election with traverse of titanium dioxide and iron oxide from group (a), cyclohexadimethylsiloxane from group (b) and a composition further comprising nylon powder from group (c) in Paper No. 19 is acknowledged. The traversal is on the ground(s) that it would not be unduly burdensome to conduct a search of all the claimed compositions. This is not found persuasive because a separate search would have to be conducted for each species and each claim requiring a different additional component of the composition. A reference anticipating or rendering obvious one species would not necessarily anticipate or render obvious another species.

It appears, however, that Applicant has misunderstood the election requirement. The Examiner required election to one group or class of substances from each of (a)-(c), not one compound or substance from each group or class. More specifically, from

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group (a) the pigments of claims 16 and 17 or the dyes of claim 20, from group (b) either linear or cyclic silicones, and from group (c) one composition containing one patentably distinct additional component. The examination has been conducted to include those substances that are within the same group or class as the elected compounds. For example, the pigments as in claims 16 and 17, cyclic silicones as in claims 25-27 and a composition containing any one of the fillers as in claim 50 have been examined.

The requirement is still deemed proper and is therefore made FINAL.

Claims 20-22, 24, 30-39, 41, 58 and 67 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species of the invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 19.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 16, 40, 45 and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is indefinite because it is unclear what Applicant intends by the phrase "staying power." This is not an art-recognized phrase and the specification does not provide a clear and concise definition of it.

Claim 16 is indefinite because it is unclear what Applicant intends by the abbreviation, PDMSs. All elements of a claim should be fully written out at the first instance of use followed by any abbreviations in parentheses.

Claim 40 is indefinite because it is unclear what is encompassed by hydrocarbon-based oil. Because it is unclear if the oil actually contains hydrogen and/or carbon, the metes and bounds of the claim cannot be determined. Removal of the term "based" would overcome this rejection.

Claim 45 is indefinite because it contains percent amounts without units. Are the percents based on weight, volume, etc.?

Claim 63 is indefinite because it appears to contain a typographical error in line 3 where the word "in" is repeated twice. Removal of one instance of the word "in" would overcome this rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 331 833 A1 (833).

EP '833 is directed to water-in-oil emulsion compositions that contain at least one alpha,omega-substituted oxyalkylenated silicone (title, abstract and page 6, formula (c)).

Claim 3 states that the oxyalkylene groups can be distributed randomly. Therefore, the

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oxyethylene and oxypropylene groups can be arranged in any order. At page 7, lines 1-5, in the alpha,omega-substituted oxyalkylenated silicone, p is 1 to 5, x is 1 to 50 and m is 5 to 100, all of which overlap the ranges of instant claims 3 and 4. R', which is equivalent to Applicants R¹ can be an alkyl group having 1-12 carbon atoms, which includes methyl as in instant claim 8. See example 1-2 at page 11 for 3.0 wt.% alpha,omega-substituted oxyalkylenated silicone.

Dynamic viscosity, reduced migration, transfer resistance and staying power are inherent properties. The emulsions of the prior art contain the same components in the same amounts as instantly claimed. Therefore, they will exhibit the same properties. Applicant has not provided any evidence showing that the emulsions of the prior art do not exhibit the instantly claimed properties. The prior art discloses the same amounts of alpha,omega-substituted oxyalkylenated silicone as instantly claimed and, therefore, contain an amount effective for reducing or eliminating the transfer or migration or improving the staying power as instantly claimed of the composition.

A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-19, 23, 25-29, 40-57 and 59-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 373 661 A2 (661) in combination with EP 0 796 615 A1 (615).

EP '661 is directed to water-in-oil emulsion cosmetics that contain an emulsifier mixture, an oily base containing a silicone oil and water. The emulsions have a viscosity of 20,000 cps or below at 25 C, which is equivalent to 200 poise or less. See the abstract. Applicant discloses at page 21, 1st paragraph that a dynamic viscosity of 100 mPa.s to 20 Pa.s is equivalent to 100 cps to 200 poise, which range is encompassed by

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EP'661. Milky lotions, body-care lotions and liquid foundations are also disclosed in the abstract.

For oxyalkylenated silicone emulsifiers as part of the emulsifier mixture, see page 3, lines 23-38. For pigments and fillers of instant claims 16, 17 and 50, see page 6, lines 49-55. The total amount of powders including fillers and pigments is from 10-40 wt.%. For a mixture of 5.0 wt.% titanium dioxide, 0.4 % red oxide, 0.7 % yellow iron oxide and 0.1% black iron oxide pigments with 3.0 % talc, see the powder component of example 5 at page 15. For cyclic siloxanes such as cyclotetrasiloxane (n=4) and cyclopentasiloxane (n=5), see page 3, lines 4-6 and examples 2-4 at pages 11-13. EP '661 discloses that the silicone oil can be use din any weight percent and that the amount of oily base, which may be only silicone oil, is from 250-45 wt.% (page 3, lines 8-14).

For about 67 wt.% of an aqueous phase containing 5.0 % of a C2-6 alcohol (ethanol), 2.0 % of a polyol (glycerol), and 0.6% of other adjuvants and active principles and about 33 wt.% of a fatty phase, see example 2. Co-surfactants are disclosed at page 3, line 15 to page 6, line 31. Claim 40 does not require any additional components because it recites "up to. If claim 40 is amended to require a hydrocarbon-based oil, it will be withdrawn as directed to a non-elected species of the invention.

Since the compositions of EP '661 contain the same amount of filler and silicone oil as instantly claimed they would be expected to have the same weight ratio of filler to silicone oil. Additionally, since EP '661 discloses the same fillers and silicone oils as instantly claimed, it would be expected to meet the formula of instant claims 56 and 57.

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EP '661 does not disclose an alpha,omega-substituted oxyalkylenated silicone.

EP '615 is directed to cosmetic compositions such as shampoos that contain at least one oxyalkylenated silicone (title and abstract). EP '615 teaches that alpha,omega-substituted oxyalkylenated silicone can be used in place of and for the same purpose as oxyalkylenated silicones wherein the oxyalkylene chains are pendant. See page 4, lines 36-55. The preferred oxyalkylenated silicones of EP '615 are those of formulas (I) and (II). See page 5, line 50 to page 6, line 5. In formula (I), when R^1 is methyl (page 5, line 55) and R^2 is $C_cH_{2c}-O-(C_2H_4O)_a(C_3H_6O)_b-R^5$ (page 5, line 25) wherein R^5 are methyl (page 5, line 56), c is 0-4, a is 0-50, n is 0-500 and m and o are 0 (page 5, lines 39-46), it encompasses the instantly claimed alpha,omega-substituted oxyalkylenated silicone of claims 3-9. EP '615 discloses that the compositions containing the oxyalkylenated silicones have a viscosity greater than 200 mPa.s (page 6, line 11).

Neither of the references teaches the average molecular weight of R (claims 5 and 9), the weight ratio of oxyethylene groups to oxypropylene groups (claims 6, 7 and 9), the average particle size of the filler (claim 53) or the shape of the filler (claim 54). A silicone meeting the limitations of instant claims 3 and 9 as described above would be expected to exhibit these characteristics. It is within the skill in the art to select optimal parameters of a composition in order to achieve a beneficial effect. One of ordinary skill in the art would have been motivated to select an optimal particle size and shape of the filler powders for aesthetic purposes. Therefore, absent evidence of unexpected results, the particle size and shape of the filler is not considered critical to the invention.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the emulsion of EP '661 using the alpha,omega-substituted oxyalkylenated silicone of EP '615 expecting to obtain similar results of good skin feel, safety and high storage stability.

Response to Arguments

Applicant's arguments filed September 26, 2001 regarding the 35 U.S.C. 102(b) rejections have been fully considered but they are not persuasive.

Applicant argues that EP '833 does not teach staying power, reduced transfer or reduced migration as instantly claimed. This argument has already been addressed in paper 12. To reiterate, these limitations are inherent properties and are not given patentable weight. Applicant has not provided any evidence of record to show that the compositions of the prior art do not exhibit these properties.

Applicant's arguments with respect to claims 1-19, 23-60 and 62-67 under 35 U.S.C. 103(a) have been considered but are moot in view of the new ground(s) of rejection.

Correspondence

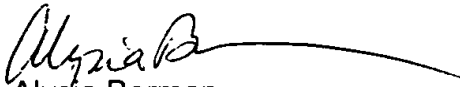
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

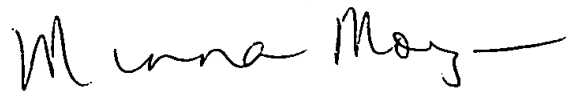
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
February 22, 2002


MINNA MOEZIE, J.D.
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